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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,736	03/30/2004	Michael E. McClurken	13045.0041USW1	8083
23552 7590 07/02/2009 MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER ROANE, AARON F	
			ART UNIT 3769	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/813,736	<b>Applicant(s)</b> MCCLURKEN ET AL.	
	<b>Examiner</b> Aaron Roane	<b>Art Unit</b> 3769	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 40-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 40-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/23/2009</u> .   | 6) <input type="checkbox"/> Other: _____                          |

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, 14-26, 40-45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al. (USPN 6,149,620) in view of Desai (5,395,312).

Regarding claim 1, Baker et al. disclose an electrosurgical device to treat tissue in a presence of radio frequency power (see for example col. 7, lines 9-14) and a fluid (see for example 450, i.e. saline) provided simultaneously from a distal portion of the device, the device having a proximal end and a distal end, the device and comprising: a handle (204 and alternate/equivalent counterparts in other embodiments); a shaft (100 and alternate/equivalent counterparts in other embodiments) extending from the handle, the shaft supporting an electrode tip (distal portion of array 504) in rigid relation (see for example col. 5, lines 12-17, col. 13, lines 1-17, col. 22, lines 11-29, col. 25, lines 4-22) to the handle and having a distal end; a fluid passage (554 and/or 557) being connectable to a fluid source of the fluid (421 and alternate/equivalent counterparts in other embodiments); the electrode tip having an electrode surface, at least a portion of the electrode tip extending distally beyond the distal end of the shaft; and at least one fluid

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outlet opening (distal openings of 554 and/or 557) in fluid communication with the fluid passage. Baker et al. fail to disclose the electrode tip and is an electrically conductive cone shaped portion. Desai disclose an electrosurgical tool having irrigation and suction capabilities, an electrode having a tip disposed at the distal end of the irrigation/suction tube/lumen and teach providing the tool with a plurality of alternate/equivalent electrode tips in the form of electrically conductive shaped portions including cylindrical, L-shaped, hook-shaped, beveled and cone shaped (see figure 4G) in order to provide electrical conduction having a particularly desired current density profile and treatment surface in order to affect a particularly desired treatment, see col. 2:32—col. 3:49, col. 4:19 – col. 5:54 and figures 1-11C, particularly figures 1-4. **During examination, claim limitations are to be given their broadest reasonable reading. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). In this case the recitation of an electrically conductive cone shaped portion, wherein cone shaped portion is broadly interpreted as a portion of a cone and/or cross-section of a cone, for as example a triangle or V shaped object which clearly is met by the electrode shown in figure 4G of Desai. Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims. See In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). See In re Prater, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and In re Winkhaus, 527 F.2d 637, 188 USPQ 129 (CCPA 1975).** Therefore at the time of the invention it would have been obvious to one of ordinary skill

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in the art to modify the invention of Baker et al., as taught by Desai, to provide the tool with a plurality of alternate/equivalent electrode tips in the form of electrically conductive shaped portions including cylindrical, L-shaped, hook-shaped, beveled and cone shaped in order to provide electrical conduction having a particularly desired current density profile and treatment surface in order to affect a particularly desired treatment.

Regarding claim 2, Baker et al. further disclose the at least one fluid outlet opening is arranged to provide the fluid from the fluid source to the electrode tip, see figures 20 and 27A-27C.

Regarding claim 3, Baker et al. further disclose at least a portion of the electrode surface has a contact angle with the fluid from the fluid source thereon of less than 90 degrees, see figures 27A-27C.

Regarding claims 4 and 5, Baker et al. further disclose the at least one fluid outlet opening (opening of 557) located at the distal end of the shaft is located between a portion of the electrode tip contained within the shaft and the distal end of the shaft, see figure 27C.

Regarding claims 6-9, Baker et al. disclose the claimed invention, see distal portion/surface of 104 and distal portion/edge of 518 in figure 27C.

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Regarding claims 10-12, Baker et al. disclose the claimed invention see col. 30-31 and figure 27C.

Regarding claims 14-17, Baker et al. disclose the claimed invention see col. 30-31 and figure 27C.

Regarding claims 18, 21, 23 and 25, Baker et al. disclose an electrosurgical device to treat tissue in a presence of radio frequency power (see for example col. 7, lines 9-14) and a fluid (see for example 450, i.e. saline) provided simultaneously from a distal portion of the device, the device having a proximal end and a distal end, the device and comprising: a handle (204 and alternate/equivalent counterparts in other embodiments); a shaft (100 and alternate/equivalent counterparts in other embodiments, see for example 578) extending from the handle, the shaft supporting an electrode tip (504 in figure 27A and 27B and 504 in figure 27C and 504 in the text) in rigid relation to the handle and having a distal end; a fluid passage (554 and/or 557) being connectable to a fluid source of the fluid (421 and alternate/equivalent counterparts in other embodiments); the electrode tip having an electrode surface, at least a portion of the electrode tip extending distally beyond the distal end of the shaft; the portion of the electrode tip extending distally beyond the distal end of the shaft comprising a neck portion and an enlarged end portion, the enlarged end portion located distal to the neck portion; and at least one fluid outlet opening in fluid communication with the fluid passage (distal openings of 554 and/or 557). Baker et al. also disclose a fluid passage (554 and/or 557) connectable to the

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fluid source and in communication with the at least one fluid opening to provide fluid from the source to the enlarged end portion of the electrode tip, see figures 27A-27C.

Baker et al. fail to disclose the electrode tip and is an electrically conductive cone shaped portion. Desai disclose an electrosurgical tool having irrigation and suction capabilities, an electrode having a tip disposed at the distal end of the irrigation/suction tube/lumen and teach providing the tool with a plurality of alternate/equivalent electrode tips in the form of electrically conductive shaped portions including cylindrical, L-shaped, hook-shaped, beveled and cone shaped (see figure 4G) in order to provide electrical conduction having a particularly desired current density profile and treatment surface in order to affect a particularly desired treatment, see col. 2:32—col. 3:49, col. 4:19 – col. 5:54 and figures 1-11C, particularly figures 1-4. **During examination, claim limitations are to be given their broadest reasonable reading. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). In this case the recitation of an electrically conductive cone shaped portion, wherein cone shaped portion is broadly interpreted as a portion of a cone and/or cross-section of a cone, for as example a triangle or V shaped object which clearly is met by the electrode shown in figure 4G of Desai. Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims. See In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). See In re Prater, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and In re Winkhaus, 527 F.2d 637, 188 USPQ 129 (CCPA 1975).**

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Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Baker et al., as taught by Desai, to provide the tool with a plurality of alternate/equivalent electrode tips in the form of electrically conductive shaped portions including cylindrical, L-shaped, hook-shaped, beveled and cone shaped in order to provide electrical conduction having a particularly desired current density profile and treatment surface in order to affect a particularly desired treatment.

Regarding claims 19, 20, 22, 24 and 26, Baker et al. disclose the claimed invention, see figures 27A-27C.

Regarding claims 40-45, Baker et al. disclose the claimed invention, see col. 23, lines 37-43, col. 30-31 and figures 27A-27C.

Regarding claim 47, Baker et al. disclose a surgical method for treating tissue comprising: providing tissue having a tissue surface; providing radio frequency power (see for example col. 7, lines 9-14) and a fluid (see for example 450, i.e. saline) to an electrosurgical device having a tip portion which simultaneously provides the radio frequency power and the fluid (entire reference) to a tissue treatment site, the tip portion comprising at least one fluid outlet opening (distal opening(s) of 554 and/or 557) and a distal end provided by an electrode; providing the fluid from the electrosurgical device; forming a localized fluid coupling with the fluid which couples the tissue surface and the electrode (entire reference), the fluid coupling localized at the tip portion of the



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electrosurgical device (see col. 30-31 and figure 27C.); providing the radio frequency power to the tissue (see for example col. 7, lines 9-14); moving the tip portion of the electrosurgical device along the tissue (inherent in dissection, cutting and/or removal); coagulating the tissue (see col. 9, line 44 through col. 10, line 6); and blunt dissecting the tissue (see col. 9, line 44 through col. 10, line 6) with the distal end of the electrosurgical device. Baker et al. fail to disclose the electrode tip and is an electrically conductive cone shaped portion. Desai disclose an electrosurgical tool having irrigation and suction capabilities, an electrode having a tip disposed at the distal end of the irrigation/suction tube/lumen and teach providing the tool with a plurality of alternate/equivalent electrode tips in the form of electrically conductive shaped portions including cylindrical, L-shaped, hook-shaped, beveled and cone shaped (see figure 4G) in order to provide electrical conduction having a particularly desired current density profile and treatment surface in order to affect a particularly desired treatment, see col. 2:32—col. 3:49, col. 4:19 – col. 5:54 and figures 1-11C, particularly figures 1-4. **During examination, claim limitations are to be given their broadest reasonable reading. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). In this case the recitation of an electrically conductive cone shaped portion, wherein cone shaped portion is broadly interpreted as a portion of a cone and/or cross-section of a cone, for as example a triangle or V shaped object which clearly is met by the electrode shown in figure 4G of Desai. Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot**

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**be fairly connected to the structure recited in the claims. See *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975).**

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Baker et al., as taught by Desai, to provide the tool with a plurality of alternate/equivalent electrode tips in the form of electrically conductive shaped portions including cylindrical, L-shaped, hook-shaped, beveled and cone shaped in order to provide electrical conduction having a particularly desired current density profile and treatment surface in order to affect a particularly desired treatment.

Claim 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al. (USPN 6,149,620) in view of Desai (5,395,312 as applied to claim 10 above.

Regarding claim 13, Baker et al. disclose three equally spaced openings (see openings 54 with equally spaced ribs 96 of USPN 6,024,733 by incorporation by reference, see figure 9). Baker et al. fail to disclose 4 equally spaced openings/fluid outlets. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a fourth equally spaced rib that would subsequently provide four equally spaced openings, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

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Claim 46 rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al. (USPN 6,149,620) in view of Desai (5,395,312 as applied to claim 47 above.

Regarding claim 46, Baker et al. in view of Desai disclose the claimed invention except for the cone shaped portion comprises an eccentric cone shaped portion. At the time of the invention, it would have been an obvious matter of design choice to one of ordinary skill in the art to use an eccentric cone shape portion because Applicant has not disclosed an eccentric cone shape portion provides an advantage, is used for a particular purpose, or solves a stated problem for that of a concentric shape cone portion. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with concentric shape cone portion because they both provide the needed electrical conduction.

### ***Response to Arguments***

Applicant's arguments filed 3/23/2009 have been fully considered but they are not persuasive. Applicant asserts (see page 2 and 3; the arguments/remarks against the 103 rejections) that 1) Desai does not disclose a three dimensional view of the tip in question (figure 4G) and 2) at best one can only determine the tip shown in figure 4G is two dimensional.

First, as the tip illustrated is composed of a physical material is inherently have three orthogonal dimension, regardless of how thick or thin any of these dimensions are. Furthermore,

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Applicant is not positively reciting a three dimensional object but again a “cone shaped portion” nor is Applicant positively reciting any extent of any one of three dimensions. Again, although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims. See *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975).

Secondly, as all the drawings are illustrated on a two dimensional object, a sheet of paper, the same statement can be made regarding the information rendered by Applicant’s drawings.

Thirdly and finally, as pointed out above during examination, claim limitations are to be given their broadest reasonable reading. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). In this case the recitation of an electrically conductive cone shaped portion, wherein cone shaped portion is broadly interpreted as a portion of a cone and/or cross-section of a cone, for as example a triangle or V shaped object which clearly is met by the electrode shown in figure 4G of Desai. Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims. See *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975).

**This action is made FINAL.**

***Conclusion***

As a courtesy to Applicant and in the hopes of expediting prosecution, the prior art made of record and not relied upon is considered pertinent to applicant's disclosure. If Applicant intends to further limit the claim language to distinguish over the prior art of record and preclude the broad interpretation of the "cone shaped portion" made above, Applicant may wish to review the following prior art that disclose cone electrodes: U.S. Patent 6,030,381 to Jones et al. is figure 2b and claim 5.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 8:30AM-7PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson can be reached on (571) 272-4768. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Roane/  
Examiner, Art Unit 3769

/Henry M. Johnson, III/  
Supervisory Patent Examiner, Art Unit  
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